

Attorney Docket No: 2006636-0064

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sontheimer, <i>et al.</i>	Examiner:	Chen, Shin-Lin
Serial No.:	10/686,782	Art Unit:	1632
Filing Date:	October 17, 2003	Confirmation No.:	7705
Title:	Diagnosis and Treatment of Neuroectodermal Tumors		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA EFS WEB FILING: WWW.USPTO.GOV

Sir:

PETITION TO WITHDRAW FINALITY AND/OR REQUEST FOR PROPER ACTION

Applicant hereby respectfully requests that finality of the Office Action mailed on April 21, 2008 be withdrawn and/or that a new Office Action be issued that is directed toward the claims as amended.

Section 707.14b of the Manual of Patent Examining Procedure (“MPEP”) provides, among other things, that “The examiner must consider the information submitted with the applicant’s reply and apply the information as the examiner deems appropriate.” Additionally, section 706.7 of the MPEP provides, among other things, that “In making such a final rejection, the examiner shall repeat or state all grounds of rejection then considered *applicable to the claims in the application*, clearly stating the reasons in support thereof” (emphasis added). In the present case, Applicant submitted an Amendment that obviated the standing rejections in a Response to Office Action dated January 24, 2008. The Examiner subsequently issued a Final Office Action directed to the claims *before* the Amendment submitted on January 24, 2008; these rejections were repeat rejections of the previous Office Action.

Indeed, in the Final Office Action mailed on April 21, 2008, the Examiner alleged in his rejection that the specification “does not reasonably provide enablement for delivering a cytotoxic moiety... by administering a *pharmaceutical composition*...” Applicant had amended claims to delete the term “pharmaceutical.” Subsequent to issuing the Office Action mailed December 31, 2007, the Examiner clarified in a telephone interview of January 16, 2008, that he did not object to claims relating to delivery of a composition. Solely in order to advance prosecution of the present case, Applicant had amended the claims to refer to such methods of delivery. Yet there is no evidence in the Final Office Action that the Examiner considered this amendment. The Examiner merely repeated the rejections he had previously issued. These rejections are clearly not applicable to the claims as amended.

Applicant respectfully submits that examination cannot progress if the Examiner does not articulate his rejection against the claims as amended. Applicant respectfully submits that the Finality of the Office Action mailed on April 21, 2007 was premature, and respectfully requests its withdrawal. At a minimum, Applicant respectfully requests that any further Action from the Examiner be directed to the claims as amended.

Respectfully submitted,

Dated: May 16, 2008

/BHJarrell/

Choate, Hall & Stewart LLP
Patent Group
Two International Place
Boston, MA 02110
Tel: 617-248-5000

Brenda Herschbach Jarrell, Ph.D.
Reg. No.: 39,223